

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Khalaf et al. Art Unit : 1654
Serial No. : 10/500,093 Examiner : Julie Ha
Filed : November 17, 2004 Conf. No. : 7660
Title : DNA MINOR GROOVE BINDING COMPOUNDS

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed March 5, 2008, Applicant elects the invention of Group 3 drawn to *N*-[3-(Dimethylamino)propyl]-2-({4-({4-(formylamino)-1-methyl-1*H*-pyrrol-2-yl]carbonyl}amino)-1-methyl-1*H*-pyrrol-2-yl]carbonyl}-amino)-5-isopropyl-1,3-thiazole-4-carboxamide. The election is made with traverse.

Applicant traverses the restriction requirement because the Examiner has applied an improper standard in making the requirement. The present application is a U.S. national stage application of a PCT application and was filed under 35 U.S.C. §371. Thus, as set forth in M.P.E.P. 1850, PCT Rules 12.1 and 13.2 must be followed where considering unity of invention.

[W]hen the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111. No change was made in restriction practice in United States national applications filed under 35 U.S.C. 111 outside the PCT.

In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2.

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Thus, the Examiner cannot make a restriction requirement if there is unity of invention. As PCT Rule 13.2 explains, there is unity of invention when "there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features" Thus, there must be "technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." Referring now to claim 65, formula I claims compounds that are minor groove binders and which must necessarily contain a "head group" defined by R¹, at least two Q groups, wherein Q may represent any one of six different heterocycles (formulae Ia-Ig), and **must** contain at least one Q group selected from Ib to Ig that is substituted with a branched, cyclic or part cyclic C₃₋₅ alkyl (as represented by one of R⁶ to R¹¹), a spacer group defined by A and a nitrogen-rich "tail group" defined by D. It is believed that this structural element defines a contribution over the prior art.

Attached is a copy of the first European Examination report. It should be noted that there is no objection to claim 16 of the European application (which is the same as claim 65 in the present application) on the grounds of lack of unity.

In view of the forgoing, Applicant requests that the restriction requirement be withdrawn and that all of the claims be considered together. Claims 95 and 98 require that the compounds therein contain at least one Q group of formula Ie. Thus, should the Examiner determine that all of the claims cannot be considered together, Applicant request that at least the entire breadth of claims 95 and 98 and the claims dependent thereupon be considered.

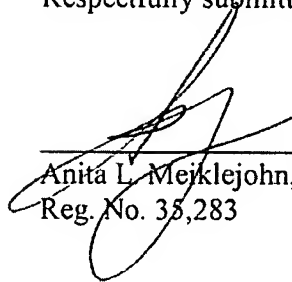
Applicant : Khalaf et al.
Serial No. : 10/500,093
Filed : November 17, 2004
Page : 3 of 3

Attorney's Docket No.: 17856-002US1

A Petition for Extension of Time with the appropriate fee is enclosed. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 3 JULY 2008



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